

**United States Government
National Labor Relations Board
OFFICE OF THE GENERAL COUNSEL**

Advice Memorandum

DATE: March 18, 2005

TO : Robert H. Miller, Regional Director
Region 20

FROM : Barry J. Kearney, Associate General Counsel
Division of Advice

SUBJECT: Agilent Technologies
Case 20-CA-32151

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512-5036-0117-3333
512-5036-0117-6667
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This case was submitted for advice as to whether the Employer violated Section 8(a)(1) and (3) by interrogating and disciplining the Charging Party after he failed to comply with an instruction to remove from an organizational website certain uses of the Employer's registered trademark. We conclude that the charge should be dismissed, absent withdrawal, because the Employer was entitled to instruct the Charging Party to stop using its trademark on the website, and, thereafter, to seek full compliance with that instruction when all of the identified offending uses of its trademark were not removed. The Employer also did not violate the Act by questioning the Charging Party about the owners of the website because the questions resulted from the Charging Party's false claim that he could not comply with Employer's instructions because he did not control the website. Finally, the disciplinary warnings and paid suspension imposed on the Charging Party did not violate Section 8(a)(3) because the Employer can establish that it would have taken the same course of action to protect its registered trademark in the absence of the Charging Party's protected activity.

FACTS

The Employer, a global test and measurement technology company, was established in 1999 as a spin-off of the Hewlett-Packard Company. The "Agilent" name was created to emphasize the independent identity of the new corporation. The new brand name and a distinctive "spark" logo were registered with the U.S. Patent and Trademark Office (USPTO) at the time. Since then, the Employer, through its in-house trademark counsel, has submitted numerous supplemental filings to USPTO to renew the Company's existing registrations and to register the Agilent trademark and logo

for an array of additional ventures and intended uses.¹ In addition to renewing and updating the Employer's USPTO filings, the Employer also protects the integrity of the Agilent trademark through a "Brand Identity System" of policies and guidelines for granting the right to use and policing uses of its trademark and logo by its licensees, customers and other third parties.²

The Charging Party, John Rose, has worked for the Employer since May 2000 as a supply planner at its Santa Rosa, California facility. By Memorandum dated January 31, 2005, we authorized the Region to issue a Section 8(a)(1) complaint, absent settlement, in Case 20-CA-31918, alleging that the Employer (1) violated Section 8(a)(1) by maintaining and enforcing a policy that prohibited employee groups that attempted to negotiate terms and conditions of employment or represent individual employees and (2) discriminatorily refused to publish in its on-line newsletter an article submitted by Rose about his recent launch of an organizational website, "Agilepeople.org," in violation of Section 8(a)(3).³

In mid-July 2004,⁴ subsequent to the events giving rise to the allegations in Case 20-CA-31918, the Employer began monitoring the contents of the Agilepeople.org website, assertedly to ensure that its registered trademark was not being misused. In the course of this review, the Employer found several arguably improper uses of its registered trademark.

On July 14, an Employer human resources manager informed Rose that he was not to use the terms "Agilent" or "Agilent Technologies" on the website where the use of those

¹ The Employer has over 150 filings in the USPTO database. Most of these filings are active registrations for existing or planned uses of the "Agilent" name. Thus, the Employer has registered the word "Agilent" for uses directly related to its test and measurement technology business and other purposes such as charitable services promoting public awareness in the fields of education, career development, curriculum development, and health and human services.

² The Employer also restricts employee use of the Agilent name and logo under its separate policy on employee groups.

³ We concluded that the additional allegation that the Employer maintained an overbroad e-mail policy should be dismissed, absent withdrawal.

⁴ All dates are in 2004 unless otherwise indicated.

terms could be interpreted as Employer authorization, sponsorship or endorsement. The manager specifically identified "Agilent Employee Association" as an unauthorized use of the Employer's trademark and referred Rose to the Employer's Brand Identity System's rules against uses of the Agilent trademark without express permission. The manager instructed Rose to remove from the website and refrain from future uses of the Agilent trademark in a manner that could imply a relationship with or endorsement by the Employer.

Following the meeting, some, but not all, of the identified offending uses of the Agilent trademark were removed from the website, and in at least one case, the phrase "Agilent Employee Association" was merely struck through rather than removed.

On July 22, the human resources manager spoke to Rose again. She told him that striking through the offending use of the Employer's trademark was inadequate because it still gave the appearance that that the Employer was sponsoring the employee association. Thereafter, most website references to Rose's group were changed to "Agilepeople" or the "Agilepeople Employee Association of America."

On October 8, Rose posted a press release entitled "Agilent Technologies Employee Association Launched" on the website. The press release contained two references to a new group for the Employer's overseas employees called the "Agilent International Employee Association (AIEA)." According to the press release, the AIEA was "a non-affiliated group of Agilent employees established to promote improved working conditions in developing nations." A link to the AIEA was also added.⁵

On October 14, the Employer met with Rose, reviewed the Employer's brand identity policy, and ordered him to remove the new references to "Agilent Technologies Employee Association" and the AIEA from the website. The Employer also gave Rose a written warning that recounts the July 14 instruction not to use the Agilent name in a manner that implied Employer endorsement, sponsorship or support, the Employer's express instruction not to use the phrase "Agilent Employee Association" and the fact that the instruction was not obeyed until after the Employer's second order to remove all the identified improper uses of its trademark. The warning orders Rose to remove the new offending uses in the October 8 press release and AIEA link because they imply Employer sponsorship and violate the

⁵ The AIEA link led to a Yahoo discussion group.

Employer's brand identity policies. Finally, the warning states that future misconduct, whether related or not, will result in a recommendation for immediate termination. Rose refused to sign the written warning, but agreed to remove the identified material from the website.

The Employer inspected the website the next day and discovered that, while the press release had been removed from the website's home page, it appeared elsewhere on the site and the link to the AIEA Yahoo site remained.

The Employer met with Rose again,⁶ and ordered him to remove the rest of the "unlawful" postings. Rose said he would relay the message to the people who were responsible for the website and ask them to make the requested changes. The Employer replied that it assumed Rose was the owner of the website. Rose responded that assumptions could be dangerous, protested that he was being singled out and retaliated against because of his involvement with Agilepeople, and stated that the website was a group effort.⁷ Rose told the Employer it should address its trademark concerns to the Agilepeople organization or issue a cease and desist order against them.

On October 20, the Employer met with and gave Rose a memorandum summarizing that meeting, including Rose's assertion that he did not own or control the Agilepeople.org website. In the memorandum, the Employer set out its reasons for disbelieving Rose's claim, and demanded that he provide the Employer with the name and contact information for the party with control so that the Employer could communicate with that person and take steps to protect Agilent's interests. Rose refused to provide the requested information. He conceded that he was a spokesperson for the Agilepeople association, but insisted that he was not responsible for all actions taken on the association's behalf. He also stated that he felt harassed and did not want other Agilepeople members to be treated the same way.

On October 21 and 22, Rose again told the Employer that he would not provide the requested names and information regarding the website's owner because the request conflicted with his and other employees' rights under the NLRA.

⁶ The Employer and Rose disagree on the date of this meeting. Rose says it took place on October 15; the Employer places it on October 18.

⁷ In fact, Rose was solely responsible for the website and its contents.

In light of Rose's continued claim that he did not own or control the Agilepeople.org site, the Employer undertook an investigation of the site's ownership. It quickly determined that the Agilepeople.org domain name had been registered anonymously through a proxy service. On October 22, the Employer contacted the proxy service, stating that it wanted to contact the domain owner in connection with concerns about the misuse of its trademark.

On November 3, Rose and one of the Employer's human resources managers had a one-on-one discussion concerning a range of issues, including the recent presidential election. The conversation briefly touched on the October 14 disciplinary warning and the October 19 memorandum. The manager told Rose that trademark identity was a very important issue for the Employer. Rose replied that the Employer had to contact Agilepeople and that he could not give out the names of the people involved because it would interfere with their organizational rights under the NLRA.

On November 4, the proxy service sent the Employer an e-mail detailing the registration and ownership history of the Agilepeople.org website. The e-mail showed that Rose was the sole registered owner of the site.

The same day, one of the Employer's human resources managers and Rose's immediate supervisor met with Rose. The manager again asked Rose for the name of the website owner so that the Employer could protect its trademark rights. Rose reiterated that he could not do so without interfering with employee NLRA rights. When the manager showed Rose a printout of the e-mail from the proxy service, Rose acknowledged that it listed his name and address, but noted that he was not the only person who could post information on the website. He also disputed the Employer's trademark claim on the merits, asserting that there had been no improper use under trademark law. The manager told Rose that the situation was very serious and that management was sending him home, with full pay and benefits, while they determined how to proceed.

On November 10, Rose's supervisor called Rose and told him he could come back to work. Upon Rose's return to work on November 15, the Employer issued Rose another memorandum summarizing events since the issuance of the October 14 disciplinary warning, including its demand that misuse of the Employer's trademark cease. The memorandum charged Rose with willfully misleading the Employer regarding the identity of the true registered owner, characterized his refusal to identify himself as the owner as "inappropriate and insubordinate," and concluded that such conduct constituted an offense for which Rose's employment could be

terminated. The memorandum further stated that the Employer would "give Rose the benefit of the doubt," but warned that any future misconduct would be carefully evaluated.

The Agilepeople.org website has been redesigned and now carries numerous disclaimers that it is not sponsored or endorsed by the Employer. The October 8 press release remains on the website, but its title has been changed to "Agilepeople Employee Association Launched at Agilent Technologies." The AIEA name has been changed to the "Agilepeople International Employee Association" in the press release and elsewhere on the website. The link to the AIEA Yahoo group has similarly been revised, and when that link is followed, a message that "[t]here is no group called agilepeopleintl" appears.

ACTION

We conclude that the charge should be dismissed, absent withdrawal, because the Employer lawfully ordered the Charging Party to stop using its trademark, thereafter disciplined and questioned him as a consequence of his refusal to follow that lawful order, and has satisfied its burden of establishing that it would have taken the same actions in the absence of protected activity.

Initially, we conclude that the Employer's trademark concerns were legitimate and not a pretext for continuing the discrimination and animus we found in Case 20-CA-31918. As set forth in the Lanham Act,⁸ the primary purpose of federal trademark law is to prevent consumer confusion over the source of goods and services.⁹ Federal trademark registration protects trademark holders from unauthorized use of their trademarks by granting them nationwide rights as the first user to register the mark with the USPTO.¹⁰

⁸ 15 U.S.C. §§ 1051 - 1127.

⁹ Trademarks protect names, including corporate names, and symbols used to identify goods or services. 15 U.S.C. § 1127(a).

¹⁰ Lanham Act, §§ 32-33, 15 U.S.C. §§ 1114-1115. There also are state and common law sources of trademark regulation, but only federal registration accords nationwide protections. Under the Lanham Act, the federal district courts have jurisdiction of trademark infringement suits. Lanham Act § 39, 15 U.S.C. § 1121. Available remedies include injunctive relief to prevent continued infringement, damages and orders to impound and destroy infringing goods. Lanham Act § 39, 15 U.S.C. § 1121.

Trademark registration is not permanent: federal trademarks have 10-year terms and can be renewed indefinitely for succeeding 10-year periods.¹¹ Trademarks can also be canceled if they are not used continuously or timely renewed.¹² Further, federal trademark rights, while effective nationwide, are not exclusive for all purposes. Rather, an applicant must identify in its registration application the statutory class or classes of goods and services for which the mark will be used.¹³ If the registrant later wants to use the same mark for a new purpose outside the registered statutory class(es) of goods or services, a separate or supplemental registration will be required. Consequently, if another party has already used the same mark (or a similar one) for that new purpose, the original registrant could, as the plaintiff or defendant in a trademark infringement action, lose the right to use the mark for the new purpose or at least not be able to object to that third party's use of its mark. The doctrine of laches also can bar an infringement suit if the trademark holder has known and inexcusably failed to object to the infringing use for a protracted period of time.¹⁴

To protect their right to use their marks for new purposes, trademark holders must "police" their marks by promptly objecting to unauthorized uses of their registered marks, demanding that such misuse cease, and, if it does not, by filing trademark infringement suits.¹⁵ Of course, the ultimate determination as to whether actionable infringement has occurred lies with the courts.

The Employer did not present any specific evidence that would establish that its response to Rose's use of its trademark was consistent with its response to prior third party uses of the Agilent trademark. However, factors such

¹¹ Lanham Act, §§ 8-9, 15 U.S.C. § 1058-1059.

¹² Thus, for a trademark registration to remain valid, a registered owner must file "affidavits of use" at certain specified intervals. See 15 U.S.C. § 1058(b)(1)-(2)

¹³ Lanham Act § 30, 15 U.S.C. § 1112.

¹⁴ Lanham Act § 33(b)(9); 15 U.S.C. § 1115(b)(9).

¹⁵ Other reasons to police third party uses are that they could cause consumer confusion, allow the third party infringer to benefit from the mark holder's investment and reputation and/or damage the mark holder's business through the distribution of inferior goods or services.

as the existence of the Brand Identity Policy, the employment of in-house trademark counsel, the restrictions on unauthorized employee use of its name and logo embodied in the policy on employee groups, and the wide array of uses and planned uses identified in its many USPTO filings, all strongly suggest that protection of the Agilent trademark has been a priority matter for the Employer. In light of the emphasis placed on its "brand identity," all of which predate Rose's organizational activities, we conclude that the Employer can meet its burden under Wright Line¹⁶ of establishing that it would have investigated and objected to the kind of uses of its trademark that appeared on the Agilepeople.org website even in the absence of Rose's organizational activities or the Company's opposition to unionization.¹⁷ We therefore conclude that the Employer's initial examination of the website and demand to remove material suggesting Employer endorsement of Agilepeople, AIEA or the website, were motivated by the Employer's legitimate trademark concerns and were not violative of the Act.

We also conclude that the Employer was thereafter privileged to seek full compliance with that lawful instruction, and that its inquiries concerning the website's ownership did not rise to the level of an unlawful Section 8(a)(1) interrogation. Thus, in Rossmore House,¹⁸ the Board

¹⁶ Wright Line, 251 NLRB 1083 (1980), enfd. 662 F.2d 899 (1st Cir. 1981). The Wright Line analysis applies to both violations of Section 8(a)(3) and violations of Section 8(a)(1). Id. at 1089.

¹⁷ See Overnite Company, 343 NLRB No. 134, slip op. at 3 (2004) (although General Counsel met the initial burden of showing employer's actions were motivated in part by its animus toward protected conduct, employer met its rebuttal burden under Wright Line where its decision to investigate employees' criminal backgrounds was also motivated by losses from recent thefts that would have caused the employer to conduct the investigation even absent any union animus); Grand Rapids Die Casting, 279 NLRB 662, 667 (1987), enfd. 831 F.2d 112 (6th Cir. 1987) (even though engaged in the protected activity of writing a grievance, union steward was insubordinate and lawfully disciplined when he refused to obey employer's order to return to work).

¹⁸ 269 NLRB 1176 (1984).

held that the test for determining whether an employee interrogation violates Section 8(a)(1) is whether, under the circumstances, the interrogation reasonably tended to restrain or interfere with the exercise of employee rights guaranteed under the Act.¹⁹ In making that determination, the Board considers such factors as the nature of the information sought, the identity of the questioner, the place and method of interrogation, and whether or not the employee being questioned is an open and active union supporter.²⁰ While some factors, such as the fact that Rose was questioned by two or more Employer managers in their offices, might militate in favor of a finding of coercion, other factors, including the fact that Rose's protected conduct was open and well known to the Employer, and that the Employer clearly told Rose that it was seeking information about the website's ownership in light of its legitimate trademark concerns, militate against a finding of unlawful interrogation.²¹ Concededly, Rose felt that his organizational activities and the identities of fellow members of Agilepeople were being probed. On the other hand, the Employer only pursued this line of inquiry after Rose had failed to comply with its lawful instruction to stop misusing the Agilent trademark on the website and after Rose falsely claimed that he could not comply because he did not control the website's contents. In these circumstances, particularly in light of the Employer's legitimate trademark concerns, we conclude that its queries regarding the ownership of the website were lawful.²²

¹⁹ Id. at 1177. See also Spartan Plastics, 269 NLRB 546, 552 (1984).

²⁰ Demco New York Co., 337 NLRB 850, 850 (2002).

²¹ Cf. Royal Manor Convalescent Hospital, Inc., 322 NLRB 354, 362 (1996) (interrogation coercive where interrogated employee was not an avowed union supporter, highest day-to-day manager conducted the questioning in his office, and the sole purpose of the questions was to determine employee's union sentiments, "the precise type of information employees are privileged to keep from their employers").

²² Cf. Midstate Telephone Corporation, 262 NLRB 1291, 1292 n. 4 (1982) (rejecting contention that employer's conduct was privileged by a desire to protect its registered trademark against "unauthorized" use on union t-shirts where there was no evidence that alleged trademark infringement was a motivating factor in employer's decision to prohibit employees from wearing the shirts).

Finally, for the reasons noted above with respect to the Section 8(a)(1) allegations, the disciplinary warnings and suspension imposed on Rose did not violate Section 8(a)(3). Thus, even assuming a prima facie case could be established that the Employer unlawfully ordered the removal of the offending references from the website and disciplined Rose for failing to do so out of animus against his protected activities, the Employer can meet its Wright Line burden that it would have followed the same course of action to protect its registered trademark in the absence of Rose's protected activity. Accordingly, the allegations that the October 14, October 20 and November 15 disciplinary warnings and memoranda and the November 4 paid suspension violated Section 8(a)(3) should be dismissed, absent withdrawal.

For all these reasons, the charge should be dismissed, absent withdrawal.

B.J.K.